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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,769	11/26/2003	Andreas Blumenthal	13913-151001/2003P00555 U	9651
32864 7590 02/08/2007 FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER STEELMAN, MARY J	
			ART UNIT 2191	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/08/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/723,769

Applicant(s)

BLUMENTHAL ET AL.

Examiner

Mary J. Steelman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/26/03, 07/09/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-18 are pending.

#### ***Drawings***

2. Drawings (FIGs. 1-6) received 07/09/2004 lack the label "Replacement Sheet" at the top of each page.

### **INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

#### **Replacement Drawing Sheets**

Drawing changes must be made by presenting replacement sheets which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments section, or remarks, section of the amendment paper. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). A replacement sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and within the top margin.

***Specification***

3. The use of the trademark JAVA has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 7-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 7 references a computer program product, which as defined in the Specification includes carrier signals (page 9). These are non statutory embodiments. Claims must be limited to machine readable storage devices.

Claims 13-18 are directed towards a computer system, but claim only software per se. Hardware features (processor, storage) to enable the software functionality may be used to provide a statutory embodiment.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for

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patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3, 6, 7-9, 12, 13-15, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 7,079,648 B2 to Griffin et al.

Per claims 1, 7, and 13:

A method comprising:

providing a test hierarchy, the test hierarchy including a collection of test methods, each test method calling test assertion methods for checking correctness of production code, each test assertion call defining a test execution flow within the test hierarchy in an event of a failure; and controlling the test execution flow inside the test hierarchy according to a parameter of the test assertion method call in the event of the failure.

Griffin disclosed (col. 8: 43-67) test methods, a test hierarchy (col. 8: 12-40), events of failure (col. 10: 25-49), and controlling the test execution flow (col. 10: 47). An example of a parameter of the test is disclosed at col. 4: 11-20 (cryptographic type identifier). Col. 11: 33 discloses a test hierarchy. Col. 12: 57-58 discloses 'computer readable media.'. Col. 16 lists reports showing test assertions.

Per claims 2, 8, and 14:

-the parameter causes instructions to continue or to abort at any level of the test hierarchy after the event.

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Col. 10: 48, 54-59, The error level to be reported if the test case fails. This may also include altering the flow of the test. Filtering provides a mechanism to handle known software inconsistencies and backward compatibility issues. Known inconsistencies should not be considered fatal test failures.

Per claims 3, 9, and 15:

-a test assertion method includes instructions for verifying an expected state of the production code.

Col. 10:43-45, whether case is expected to succeed...is not expected to succeed...

Per claims 6, 12, and 18:

-the test hierarchy is implemented in a unit test environment.

Col. 11: 33-37, hierarchical tier from least to most complicated.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4, 5, 10, 11, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 7,079,648 B2 to Griffin et al., in view of US Patent Application Publication 2004/0133880 A1 to Paternostro et al.

Regarding Claims 4, 5, 10, 11, 16, and 17:

-the test hierarchy is implemented using an object oriented programming language including at least one of ABAP (advanced business application program language), Java programming language, C++ programming language, and C# programming language.

-the test hierarchy is implemented using a procedural programming language including at least one of C programming language, Fortran programming language and Pascal programming language.

Griffin disclosed col. 6:66-col. 7: 13, internal 'classes' for the exemplary CSP tester, as would be found in C programming languages. Griffin disclosed (col. 14: 36-42) program modules including routines, programs, objects, components, data structures, etc., as would be found in C programming. Griffin failed to explicitly disclose ABAP (advanced business application program language), Java programming language, C++ programming language, and C# programming language, C programming language, Fortran programming language and Pascal programming language.

However, Paternostro disclosed [0034]testing frameworks, including MinUnit for C, CppUnit for C++, and NUnit for net applications, as examples of suitable programming languages.

One of ordinary skill in the art would be motivated to use such a language to process business programs, or government programs (col. 1: 32), as the basis for reliably identifying the user (col.

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1: 53). Col. 2: 13-15, By allowing the introduction of customized security packages, an operating system can better address the needs of a broad set of customers.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Steelman, whose telephone number is (571) 272-3704. The examiner can normally be reached Monday through Thursday, from 7:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Zhen can be reached at (571) 272-3708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mary Steelman

01/18/2007

